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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,786	06/21/2002	Lothar Fannasch	048662-0130	5044

22428 7590 03/23/2004

FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER

WILLIAMS, JAMILA O

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/069,786

Applicant(s)

FANNASCH ET AL.

Examiner

Jamila O Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1,2,5-8,10 are rejected under 35 U.S.C. 102(e) as being anticipated by '010 to Corniglion. Corniglion discloses a card shaped data carrier comprising at least one layer into which visually readable information is introduced in the form of a change in the optical property on the basis of a material change effected irreversibly by a laser beam, wherein the absorption capacity of this layer for at least one wavelength is at least partly reduced as a result of the laser radiation (column 1 of the specification); wherein the layer has colored pigments which,

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under the influence of laser radiation with the column 2); at least one of the layers is at least partly transparent to visible light (column 3 lines 15-21); wherein the layers, whose absorption capacity is reduced under influence of the laser radiation, are arranged on a white substrate layer (column 3 line 15); wherein a covering layer that is transparent to visible light is arranged over the layers whose absorption capacity is reduced under the influence of the laser radiation (column 3); the method characterized by the provision of a card shaped data carrier which has at least one layer whose absorption capacity for at least one wavelength is at least partly reduced as a result of the laser radiation, acting on this layer of the data carrier with laser radiation, in order to reduce the absorption capacity of this layer for the wavelength (column 2).

3. Claims 1, 3-4, 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by '410 to Holbein. Holbein discloses a card shaped data carrier comprising at least one layer into which visually readable information is introduced in the form of a change in the optical property on the basis of a material change effected irreversibly by laser beam wherein the absorption capacity of this layer for at least one wavelength is at least partly reduced as a result of the laser radiation (column 4 lines 60-67), wherein two or more layers, with each having a different absorption capacity of at least one wavelength and the absorption capacity of at least one layer for at least one wavelength is at least partly reduced as a result of the laser radiation (column 5 lines 9-24); wherein at least two layers each of which has a respectively different absorption capacity for a different wavelength,

the absorption capacity of a first layer for a first wavelength being at least partly reduced under the influence of the laser radiation of the first wavelength and the absorption capacity of a second layer for a second wavelength being at least partly reduced under the influence of the laser radiation of the second wavelength (column 5 lines 9-24, additionally, the wavelength would inherently decrease with the decrease of material during laser radiation); the method comprising the provision of a card shaped data carrier which has at least one layer whose absorption capacity for at least one wavelength is at least partly reduced by laser radiation and acting on the layer of the data carrier with laser radiation, wherein the data carrier which has two or more layers and wherein the data carrier which has at least a first and second layer each of which has a respectively different absorption capacity for a different wavelength (column 5 lines 9-24).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Corniglion. Corniglion discloses all of the elements of the claims but for varnish layers, as recited in claim 9. Coringlion teaches the coatings as suggested by

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claim 9 in column 3 lines 7-20 of the specification. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use these teachings for the purpose of providing better color pigments.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O Williams whose telephone number is 703-305-3312. The examiner can normally be reached on 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'D. Banks', with a long horizontal line extending to the right.

**DERRIS H. BANKS**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700